

As pointed out by the Examiner, claim 13 was erroneously amended so as to include language from claim 10. For purposes of clarity, Applicant has, by this amendment, cancelled claim 13 and added new claim 18 that reflects the intended amendment to claim 13.

Claims 1, 4-5, 7-10, 12-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,220,538 to Brown, et. al ("the Brown patent"). Applicant incorporates and preserves for appeal each of the arguments presented in its response filed February 28, 2002. While Applicant disagrees with the Examiner's assertion that Brown et al. teach applying a colored coating to only the edge of the lens, Applicant has amended claims 1 and 9 to clarify that the colored coating is effective to reduce the appearance of a white ring along the perimeter of the face of said lens. This is supported in the specification at, e.g., page 2, lines 1-10, and page 3, lines 10-21. Applicant has also added new claim 17 which corresponds to claim 1 (prior to this amendment) but adds the limitation that the colored coating be opaque.

Brown et al. fail to teach or suggest applying to the edge of a lens a colored coating which is either opaque or is colored to an extent that it is effective to reduce the appearance of a white ring along the perimeter of the face of the lens. In fact, Brown et al. teach away from such a colored coating at column 5, lines 48 through 55, wherein they teach that a transparent to highly translucent and colorless material is preferred for their coating because a colored edge coating is distracting to the wearer and unacceptable cosmetically. In view of the discussion at column 5 of the Brown patent, that reference clearly leads one of ordinary skill in the art away from the present invention as claimed. The Court of Appeals for the Federal Circuit has consistently held that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." In re Fine, 5 USPQ 2d, 1596, 1599 (Fed. Cir. 1988). The fact

that Brown specifically teaches away from the present invention as claimed renders that reference inapplicable to the pending claims. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). Brown clearly fails to disclose structure positively recited and claimed in applicant's independent claims.

Claims 1, 3, and 8-10, 12-14 and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Grendahl. For the reasons set forth below, Applicant respectfully traverses.

Grendahl discloses an artificial hydrogel lens implant for replacement of the natural lens in the eye. The present invention, on the contrary, relates to optical lenses for use in eyeglasses. See, e.g., the "Field of the Invention" as set forth on page 1, lines 1-4 of Applicant's specification. Applicant has, by this amendment, clarified the claimed invention by amending claims 1 and 9 to set forth that the recited "lens" is an optical lens for use in eyeglasses.

The prior art which can be considered in determining obviousness is that in the inventor's field of endeavor and analogous arts. Lamont v. Berguer (BPAI 1988) 7 PQ2d 1580; In re Deminski (CAFC 1986) 796 F2d 436, 230 USPQ 313; In re Grout (CCPA 1967) 377 F2d 1019, 153 USPQ 742; In re Van Wanderham (CCPA 1967) 378 F2d 981, 154 USPQ 20, In re Wood et al. (CCPA 1979) 599 F2d 1032, 202 USPQ 171.

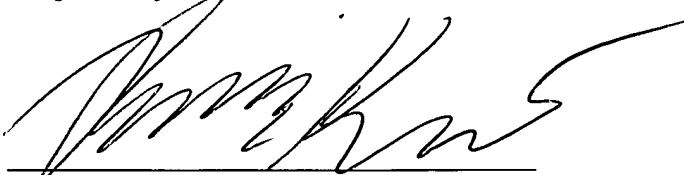
Grendahl fails to teach or suggest, *inter alia*, applying to the edge of an optical lens for use in eyeglasses a colored coating which is either opaque or is colored to an extent that it is effective to reduce the appearance of a white ring along the perimeter of the face of the lens.

Claims 2 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, et al., in view of U.S. Patent No. 4,547,397 to Burzynski, et al., and claims 6 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, et al. As is set forth above, Brown et al. fail to teach or suggest applying to the edge of a lens a colored coating which is either opaque or is colored to an extent that it is effective to reduce the appearance of a white ring along the perimeter of the face of the lens, and in fact teach away from such a colored coating. Thus, claims 2, 6, 11 and 15 are patentable by virtue of their dependence upon claims 1 and 9.

### **CONCLUSION**

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that claims 1-18 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,



Richard E. Kurtz, II (Reg. No. 33,936)  
Attorney for Applicants  
GREENBERG TRAURIG  
1750 Tyson's Boulevard, Suite 1200  
McLean, VA 22102  
(703) 749-1330  
E-mail: KurtzR@gtlaw.com

Filed: February 20, 2003

VERSION SHOWING CHANGES

Below is a redlined version of the amended claims showing the changes made by this amendment. Text which was deleted is enclosed between brackets, and inserted text is underlined:

1. An apparatus, comprising:

[A] an optical lens for use in eyeglasses, said lens having an edge; and,  
a colored coating affixed to at [lest] least a portion of only the edge of the lens, said colored coating being effective to reduce the appearance of a white ring along the perimeter of the face of said lens.

9. A method of applying a colored coating to [a] an optical lens for use in eyeglasses, said lens having an edge, comprising applying the colored coating to at least a portion of the edge of the lens such that the colored coating is affixed only to the edge of the lens, said colored coating being effective to reduce the appearance of a white ring along the perimeter of the face of said lens.

[13. The method of claim 12 further comprising removing any excess colored coating from the face of the lens.]

17. An apparatus, comprising:

an optical lens for use in eyeglasses, said lens having an edge; and,  
an opaque colored coating affixed to at least a portion of only the edge of the lens.

18. The method of claim 12, wherein the heat source is an ultraviolet light.